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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.               | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------------|------------------|
| 09/980,468   | 12/03/2001  | Ernst Heinz          | 0093/00029                        | 3433             |
| 26474  | 7590        | 02/25/2004           |                                   |                  |
| KEIL & WEINKAUF<br>1350 CONNECTICUT AVENUE, N.W.<br>WASHINGTON, DC 20036 |             |                      | EXAMINER<br>MCELWAIN, ELIZABETH F |                  |
|  |             |                      | ART UNIT                          | PAPER NUMBER     |
|  |             |                      | 1638                              |                  |

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/980,468

Applicant(s)

HEINZ ET AL.

Examiner

Elizabeth F. McElwain

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2001 and 14 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-20, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-14, 16-20, 22 and 23 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 and 4-12, to the extent the claims are drawn to SEQ ID NO: 1.

Group II, claim(s) 1 and 4-12, to the extent the claims are drawn to SEQ ID NO: 3.

Group III, claim(s) 1 and 4-12, to the extent the claims are drawn to SEQ ID NO: 11.

Group IV, claim(s) 2 and 3, to the extent the claims are drawn to an amino acid encoded by SEQ ID NO: 1.

Group V, claim(s) 2 and 3, to the extent the claims are drawn to an amino acid encoded by SEQ ID NO: 3.

Group VI, claim(s) 2 and 3, to the extent the claims are drawn to an amino acid encoded by SEQ ID NO: 11.

Group VII, claim(s) 13 and 16-18, to the extent the claims are drawn to SEQ ID NO: 8.

Group VIII, claim(s) 14 and 16-18, to the extent the claims are drawn to SEQ ID NO: 10.

Group IX, claim(s) 19 and 23, claims are drawn to an unsaturated fatty acid.

Group X, claim(s) 19 and 23, claims are drawn to an unsaturated fatty acid.

Group XI, claim(s) 20, claims are drawn to a triglyceride.

Group XII, claim(s) 22, claims are drawn to use of a nucleic acid of claim 1 or fragment to isolate a genomic sequence.

2. The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: a delta-6 desaturase gene was known in the prior art, as evidenced in the specification at page 2, line 2. Therefore, there is no special technical feature linking the claimed inventions of Groups I-III or any of Groups I-XII. Furthermore, the nucleic acids of Groups I-III do not share a special technical feature with the polypeptides of Groups IV-VIII. According to the PCT Administrative Instructions, for molecules to be of a similar nature, they need to share a common core structure and a common property or activity. These groups do not meet the criteria of Markush Practice in PCT Administrative Instructions, Annex B because a DNA molecule and a protein molecule share neither a common structure nor a common function. Thus Unity of Invention is Lacking between Groups I-III and IV-VIII. In addition, the fatty acids and triglycerides of Groups IX-XI differ structurally and functionally one from each of the others, as well as differing structurally and functionally from each of the nucleic acids of Groups I-III and the polypeptides of Groups IV-VIII. Finally, with regards to Group XII, the method claim requires a nucleic acid, which is of a different scope than the nucleic acids of Groups I-III, wherein the nucleic acid may be a fragment and would have different properties than the full coding sequence.


3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (571) 272-0802. The examiner can normally be reached on increased flex time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Elizabeth F. McElwain  
Ph.D. Level Examiner  
Art Unit 1638

EFM